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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Scala Collections Limited

Serial No. 75/222,500

J. Andrew McKinney, Jr. of Epstein, Edell & Retzer for
Scala Collections Limited.

Maria-Victoria Suarez, Trademark Examining Attorney, Law
Office 102 (Thomas V. Shaw, Managing Attorney).

Before Hanak, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Scala Collections Limited¹ (applicant) filed a
trademark application to register the mark ARTIGIANO (typed
drawing) on the Principal Register for goods ultimately
identified as "women's fashion wear and outerwear, namely,
suits, jackets, skirts, trousers, shorts, blouses, dresses,
sweaters, jumpers, pullovers, tunics, cardigans,
waistcoats, blazers, halter and/or tank tops, vests,

¹ The application was originally filed in the names of Glyn Locke
and Claire Locke. Reel and Frame No. 1657/0777 reflects the

turtlenecks, polo shirts, T-shirts, sweatshirts, swimsuits, coats, raincoats, anoraks, parkas, scarves, belts, gloves and foot[]wear" in International Class 25.² The application includes a statement that the "English translation of ARTIGIANO is 'artisan.'"

The examining attorney³ ultimately refused to register the mark under Section 2(d) of the Trademark Act because of a registration of the mark ARTISANS, INC. (in typed form) for "clothing; namely, shirts, sweaters, jackets, T-shirts and caps" in International Class 25.⁴ 15 U.S.C. § 1052(d).

After the examining attorney made the refusal final, this appeal followed. Both applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney's position is that the "English translation of the applicant's mark ARTIGIANO is 'artisan.' The applicant's mark is essentially the foreign equivalent of registrant's mark. According to the well-established doctrine of foreign equivalents, an applicant may not register foreign words or terms if the English-language

assignment from the original applicants to Scala Collections Limited.

² Serial No. 75/222,500, filed January 7, 1997. The application is based on applicant's ownership of United Kingdom Registration No. 2004930.

³ The current examining attorney in this application was not the original examining attorney.

⁴ Registration No. 1,687,942 issued on May 19, 1992, renewed. The registration contains a disclaimer of the term "Inc."

equivalent has been previously registered for related products or services." Examining Attorney's Br. at 4. The examining attorney also notes that "applicant's goods are essentially the same as the registrant's goods." Id. at 5. Therefore, the examining attorney concluded that there would be a likelihood of confusion in this case.

Applicant, on the other hand, argues that the marks are distinguishable because "artisan" is a well-known English word that "is synonymous with craftsman and craftsmanship." Applicant's Br. at 1. Furthermore, the actual translation of the term "Artigiano" would "play almost no role in conveying meaning to the consumer." Id. at 2. Applicant points out that registrant's mark is two words, whereas applicant's mark "is a single stylish Italian word ending in a vowel." Response dated October 10, 1999, p. 2. Applicant goes on to argue that it is selling "exotic, Italian-made fashion wear" and there has been no confusion. Id. at 2. When considered in their entirety, applicant submits that confusion is unlikely.

We affirm the refusal to register under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d).

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re

E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by discussing whether the involved goods are related. We must consider the goods as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("'Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services [or goods] recited in applicant's application vis-à-vis the ... services [or goods] recited in [a] ... registration, rather than what the evidence shows the ... services [or goods] to be'"). See

also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Applicant's and registrant's identifications of goods include sweaters, jackets, and T-shirts. Therefore, the goods are, at least in part, identical. As discussed above, we are constrained to consider the issue of likelihood of confusion based on the goods identified in the application and registration. Therefore, applicant's argument that its clothing is exotic, Italian-made fashion wear is not viable. Even if applicant's goods were limited to exotic, Italian-made clothing, registrant's goods are not limited in any way so these goods would still overlap applicant's goods. Nothing in the registration's identification of goods prevents registrant from also using its mark on "exotic, Italian-made fashion wear." Also, both applicant's and registrant's customers would overlap and nothing suggests that the customers for sweaters,

jackets, and T-shirts are limited to sophisticated purchasers. Even if the purchasers of applicant's and registrant's clothing are sophisticated, that would not mean that there would be no likelihood of confusion.

Octocom Systems, 16 USPQ2d at 1787.

We now turn to the issue of the similarity of the marks. "If the services [or goods] are identical, 'the degree of similarity necessary to support a conclusion of likelihood of confusion declines.'" Dixie Restaurants, 41 USPQ2d at 1534, quoting, Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Here, since the goods are, at least in part, the same, it is clear that the marks do not have to be as similar.

There are several differences between the marks in this case. One difference is that registrant's mark includes the disclaimed word "Inc." "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code

Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). The inclusion of the term "Inc." in registrant's mark "merely indicates the type of entity which performs the services, and thus has no service mark significance." In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998). Similarly, the ".com" portion of marks has not been given much significance. See Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1558 (9th Cir. 1999) (observing that the differences between the mark "MovieBuff" and the domain name "moviebuff.com" are "inconsequential in light of the fact that Web addresses are not caps-sensitive and that the '.com' top-level domain signifies the site's commercial nature").

Another difference is that applicant uses the Italian word for "artisan" while registrant uses the English plural of the same word. The difference between a singular and a plural term does not seriously affect the likelihood of confusion analysis. Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 342 (CCPA 1957) ("There is no material difference in the trademark sense between the singular and plural form of the word 'Zombie' and they will therefore be regarded as the same mark").

The main difference between the marks is that the words ARTISANS and ARTIGIANO are not identical. Our primary reviewing court has provided guidance on how marks that are the foreign equivalent of English words are to be analyzed to determine if there is a likelihood of confusion. In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). "The test to be applied to a foreign word vis-a-vis an English word with respect to equivalency is not less stringent than that applicable to two English words." 220 USPQ at 113. Here, there is no dispute that the words are equivalent. Applicant merely argues that the "actual translation into English and the meaning of the English word play almost no role in conveying meaning to the consumer who is shopping for fashionable clothes." Applicant's Br. at 2.

Next, the "similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to source." Id. In this case, while the terms are certainly not identical, both words begin with the same four letters "ARTI-." Thus, the marks have similarities in sound and appearance. The remaining letters "-SANS" in the registered mark and "-GIANO" do not create a drastically different sound or appearance in the

marks. Even if the marks were very different, there still may be a likelihood of confusion because of the similarity in meaning alone. In re Ithaca Industries, Inc., 230 USPQ 702 (TTAB 1986) (LUPO, the Italian word for "wolf," for men's and boys' underwear and WOLF for sportswear held to be confusingly similar). There, the Board held that "Italian is a common, major language in the world and is spoken by many people in the United States." Id. at 704-05. In addition, the terms "ARTISANS" and "ARTIGIANO" are significantly different from "TIA MARIA" and "AUNT MARY." The Board held that a person familiar with both English and Spanish would simply accept the term TIA MARIA and AUNT MARY without translating it into its English or Spanish equivalent. In re Tia Maria, Inc., 188 USPQ 524, 526 (TTAB 1975). In the present case, there is no reason to believe that the common word ARTISANS in English or ARTIGIANO in Italian would not be translated by a person familiar with both languages. Besides the differences in the marks in that case, the differences between the goods and services, canned fruits and vegetables and restaurant services, was a significant factor in finding no likelihood of confusion.

We also note that while registrant's mark may suggest "simple and sturdy craftsmanship to the average American" (Applicant's Br. at 2), there is no reason to believe that

applicant's mark would not have a similar connotation to the Americans familiar with the Italian language. Also, the fact that another registration for clothing containing the term "artisan" was previously registered would not support the registration of another confusingly similar registration.

Finally, applicant has attached two statements from foreign companies that have been "manufacturing high quality women's fashion for" applicant. Both letters report that applicant's mark is "not used by any other Italian fashion retailer ... [and] is therefore distinctive of Italian goods made exclusively for" applicant. First, the fact that applicant's foreign manufacturers report that no other Italian fashion retailer is using applicant's mark is hardly significant on the issue of likelihood of confusion in the United States. Second, it is not clear that the declarants were even aware of registrant's mark or the doctrine of foreign equivalents. Third, since applicant has not even alleged that it is using the mark in commerce the allegation of a lack of confusion is not significant. Fourth, even if there was use in commerce and no actual confusion, the absence of actual confusion does not equate to no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390,

396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).

When we consider that the goods in this case are at least in part identical, the meanings of the marks are identical, and the marks are somewhat similar in sound and appearance, we conclude that there is a likelihood of confusion. To the extent that there are any doubts about the likelihood of confusion, we resolve them, as we must, in favor of the prior registrant and against the newcomer. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 355, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.